REMARKS

Claims 1-3, 4, 5, 9, 10, 12, 13 have been cancelled without prejudice to the filing of continuing applications.

New claims 19-22 have been added. New claims replace cancelled claims 5, 10, 12 and 13. Claims 19 and 20 have been added pursuant to the Examiner's suggestion under "Claim objections" on page 2 of the Office Action.

The new claims are fully supported by the specification as originally filed. Thus, no new matter is added by the amendments herein.

Rejection under 35 USC 102

Claims 4 and 9 which stand rejected under 35 USC § 102(b) as being anticipated by Yani et al., U.S. Patent No. 5,696,166 ("Yani et al."), have been cancelled.

Rejection under 35 USC 103

Claims 4-13 are rejected under 35 USC § 103(a) as being unpatentable over Yani et al. in view of Wollard et al., Prostaglandins 1989, Vol. 38(4) pages 465-71 and Herbertsson et al., J. of Lipid Research, 1998 Vol 39, pages 237-244.

The Examiner states that Yani et al., which teaches 12-HETE, does not per se teach inhibition of a fibroblast to an adipocyte. Nevertheless, the Examiner concludes that, since 12-HETE is an arachidonic metabolite, one of ordinary skill in the art would

have expected differentiation of a fibroblast to occur anyway because arachidonic acid metabolites inhibit adipocyte production which elicits inflammatory response via prostaglandin synthesis.

This rejection is respectfully traversed.

Not only is the Examiner's assumption not supported but, more importantly, it is clearly contrary to the knowledge of one of ordinary skill in the art. In this regard, the Examiner's attention is drawn to the specification at page 1, lines 10-15, which states that PG52 is one of the arachidonic acid metabolites and to page 1, lines 31-38, which states that PG52 does not inhibit but accelerates differentiation of fibroblasts into adipocytes.

Thus the rejection is not well founded.

The Examiner further states that "Herbertsson et al., teach (on page 240, right hand side column underlined), of the detection of 12(S)-HETE to other cells, and in the discussion section on page 242 teach of the expression in preadipocytes which appears to inhibit differentiation to adipocytes as in claim 10." The Examiner then concludes that the method of inhibition would be expected from the teaching in the Herbertsson et al. reference and that the claims are thus *prima facie* obvious over the cited prior art.

This rejection is respectfully traversed.

On page 240, right column, Herbertsson et al. state as follows :

"3T3-L1 preadipocytes bound approximately the same amount of 12(S)-HETE as Lewis lung carcinoma cells. When these cells had been differentiated to adipocytes, the binding capacity was reduced about six times."

This statement by Herbetsson et al. means that as the cells in question differentiate to adipocytes, the differentiation of the 3T3-L1 preadipocytes into adipocytes was not inhibited by the "binding" of 12(S)-HETE.

On page 242, right column, Herbertsson et al. states

"12(S)-HETE binding to a 650 kDa cytosolic component was also demonstrated in human promonocytic (U937), erythroleukemia (HEL) cells, and murine 3T3-L1 preadipocytes. The relative amount of....."

Inhibition of the differentiation of preadipocytes is neither disclosed nor suggested in that paragraph.

Thus, the rejection under 35 USC 103 based on the two mentioned passages of Herbertsson is not founded.

Applicants respectfully submit that the above arguments overcome the rejection under 35 U.S.C. § 103. Reconsideration and withdrawal of the rejection is solicited.

In view of the above amendments and remarks, Applicants respectfully submit that the claims are in condition for allowance. A Notice of Allowance is therefore respectfully solicited.

The Applicants urge the Examiner to contact the Applicants' undersigned representative at (312) 913-2114 if he believes that a discussion would expedite prosecution of this application.

Respectfully submitted,

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